

Practitioner's Docket No. 51919-1041

PATENT

REISSUE APPLICATION BY ASSIGNEE, OFFER TO SURRENDER
(37 C.F.R. § 1.178)

To the Assistant Commissioner for Patents:

The undersigned makes this statement as part of the accompanying reissue application for the reissue of letters patent number 5,208,907 for an improvement in Method for Generating a Display Utilizing Objects in an Object List granted on May 4, 1993, to Shelton et al. and declares that (Eclipsys Corporation)

☐ he ☐ she ☒ it

is now owner by assignment of the entire interest in said original patent and hereby offers to surrender said letters patent.

CERTIFICATION UNDER 37 C.F.R. § 1.10*
(Express Mail label number is mandatory.)
(Express Mail certification is optional.)

I hereby certify that this correspondence and the documents referred to as attached therein are being deposited with the United States Postal Service on this date October 9, 2001, in an envelope as "Express Mail Post Office to Addressee," service under 37 C.F.R. § 1.10, Mailing Label Number EE789318661US addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20291.

Julie Campbell

(type or print name of person mailing paper)

Julie Campbell

(Signature of person mailing paper)

WARNING: Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. § 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

***WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. § 1.10(c).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

(Reissue Application by Assignee, Offer to Surrender (37 C.F.R. § 1.178) [17-3]—page 1 of 2)

09974515-10001

STATEMENT BY ASSIGNEE

Attached is a "STATEMENT UNDER 37 C.F.R. 3.73(b)," establishing the right of the assignee to take action in this reissue.

Date: 10/09/01

Eclipsys Corporation

(type or print name of assignee)

Jack Risenhoover

Signature Jack Risenhoover, Secretary & General
(type or print name of signatory and title if signing on behalf of an entity) Counsel

NOTE: This form may be used when the inventor is dead. It may also be used, with appropriate changes, when the reissue application does not seek to enlarge the claims of the original patent.

097435-100501
F05001-51542660

Practitioner's Docket No. 51919-1041

PATENT

ASSENT BY ASSIGNEE FOR FILING OF REISSUE APPLICATION

NOTE: The written assent of all assignees, if any, owning an undivided interest in the original patent must be included in the application for reissue. 37 C.F.R. 1.172(a).

This is part of the application for a reissue patent filed herewith based on the original patent identified as follows:

Richard Edward Shelton, Ronald Evan Norden-Paul, Audree Arne Thurman, and
Name of Patentee Stanley Carl Person

5,208,907
Patent Number

May 4, 1993
Date Patent Issued

Method for Generating a Display Utilizing Objects in an Object List
Title of Invention

Eclipsys Corporation

I am an assignee owning

☒ an undivided interest to the above original patent.

☐ a _____% (per cent) interest in the above original patent.

I assent to the accompanying application for reissue.

Attached is a "Statement under 37 C.F.R. § 3.73(b) — Establishing Right of Assignee to Take Action."

Eclipsys Corporation
Name of assignee

Jack Risenhoover
Signature of person signing for assignee

Date: 10/09/01

Jack Risenhoover, Secretary & General Counsel
(type or print name and title of person signing for assignee)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Application Serial No.: 07/540,382

Filed: 06/19/1990

For: Method for Generating a Display Utilizing Objects in an Object List

Patent No.: 5,208,907

Issue Date: May 4, 1993

Assistant Commissioner for patents

Washington, D.C. 20231

**CERTIFICATE UNDER 37 C.F.R. §3.73(b)
ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION**

1. The assignee of the entire right, title and interest hereby seeks to take action in the PTO in this matter.

IDENTIFICATION OF ASSIGNEE

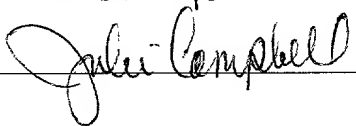
2. The assignee of this matter is:

**ECLIPSYS CORPORATION
777 East Atlantic Avenue, Suite 200
Delray Beach, Florida 33483**

PERSON AUTHORIZED TO SIGN

3. Scott A. Horstemeyer
Attorney for Assignee

I hereby certify that this correspondence is being deposited with the United States Postal Service, as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on October 9, 2001



4. A chain of title from the inventor(s) to the current assignee is shown below:
- a. From: Richard E. Shelton, Ronald E. Norden-Paul, Audree A. Thurman
and Stanley C. Person
To: Emttek Health Systems, Inc.
Recorded in PTO: Reel: 9279 Frame: 0220
 - b. From: Emttek Health Systems, Inc.
To: Eclipsys Corporation
Recorded in PTO: Reel: 010871 Frame: 0697

DECLARATIONS

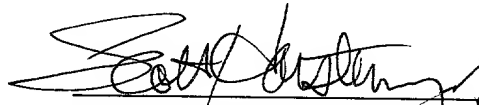
5. I, the undersigned, have reviewed all the documents in the chain of title of the

☐ application
☒ patent

matter identified above and, to the best of my knowledge and belief, title is in the assignee identified above.

6. I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

7. I, the person signing below, aver that I am empowered to sign this statement on behalf of the assignee.



Scott A. Horstemeyer; Reg. No. 34,183

Tel. No. 770-933-9500
Customer No.: 24504

Docket No. 51919-1041

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**
100 Galleria Parkway, Suite 1750
Atlanta, Georgia 30339-5948

Under the Paperwork Reduction Act of 1985, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION DECLARATION BY THE ASSIGNEE

Docket Number (optional)
51919-1041

I hereby declare that:

My residence and post office address and citizenship are stated below next to my name.

I am authorized to act on behalf of the following assignee: _____

and the title of my position with said assignee is: Eclipsys Corporation

The entire title to the patent identified below is vested in said assignee.

Name of Patentee(s): Stanley C. Person
Richard Edward Shelton, Ronald Evan Norden-Paul, Audree Anne Thurman, and

Patent Number 5,208,907 Date of Patent Issued May 4, 1993

Title of Invention

Method for Generating a Display Utilizing Objects in an Object List

I believe said patentee(s) to be the original, first and sole/joint inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled Method for Generating a Display Utilizing Objects in an Object List

the specification of which

☒ is attached hereto.

☐ was filed on _____ as reissue application number _____ / _____
and was amended on _____
(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.

☐ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☒ by reason of other errors.

At least one error upon which reissue is based is described as follows:

See attached Page 4 of 4 "Statement of Inoperativeness"

[Attach additional sheets, if needed.]

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

[Page 1 of 4]

Burden Hour Statement: This form is estimated to take 0.5 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

(Reissue Application Declaration by the Assignee (PTO/SB/52) [17-6.3]-page 1 of 2)

100901 STS 100901

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

(REISSUE APPLICATION DECLARATION BY THE ASSIGNEE, page 2)

Docket Number (Optional)

51979-1041

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Name(s)

Registration Number

Scott A. Horstemeyer

34,183

Correspondence Address: Direct all communications about the application to:

☒ Customer Number

24504

Place Customer
Number Bar Code
Label Here

Type Customer Number Here

OR

☒Firm or
Individual
Name

Scott A. Horstemeyer

Thomas, Kayden, Horstemeyer & Risley, L.L.P.

Address

100 Galleria Parkway

Address

Suite 1750

City

Atlanta

State

GA

Zip

30339

Country

USA

Telephone

770-933-9500

Fax

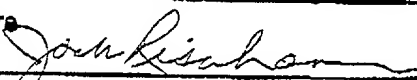
770-951-0933

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Full name of person signing (given name, family name)

Jack Risenhoover, Secretary and General Counsel for Eclipsys Corporation

Signature



Date

10/09/01

Address of Assignee

777 East Atlantic Avenue, Suite 200, Delray Beach, FL 33483

Patentee

Richard Edward Shelton

Citizenship

USA

Residence/Post Office Address

2710 W. Obispo Circle, Mesa, AZ

Patentee

Ronald Evan Norden-Paul

Citizenship

USA

Residence/Post Office Address

2050 S. Longmore, Mesa, AZ

(Page 2 of 4)

(Reissue Application Declaration by the Assignee (PTO/SB/52) (17-6.3)—page 2 of 2)

T06001"51542660

ADDITIONAL PATENTEE NAMES AND ADDRESSES

Patentee: Audree Anne Thurman
Address: 2222 W. Krystal Way, Phoenix, AZ
Citizenship: USA

Patentee: Stanley Carl Person
Address : 1242 E. Gary Circle, Mesa, AZ
Citizenship: USA

STATEMENT OF INOPERATIVENESS

An argument can be made that U.S. Patent No. 5,208,907 may be partly inoperative under 35 U.S.C Section 112 based upon potentially unclear language in some of the claims of the patent, which became apparent during a court proceeding of *Scheduling.com, Inc. v. Eclipsys Corporation and Emtek Health Care Systems, Inc.*, Civil Action No. Civ00-496-TUC-WDB, in the United States District Court for the District of Arizona to enforce the patent. At least one error being relied upon as the basis for the reissue is as follows.

Claim 1, step (c), reads as follows:

"using said processing means, assigning a plurality of tiles to each of said objects in said object list, at least one of said tiles being assigned to a group of said objects, and at least a second of said tiles being assigned to an individual one of said objects"

An argument is being made by a party to the aforementioned litigation that claim 1 is invalid under 35 U.S.C Section 112, because the specification of U.S. Patent No. 5,208,907 does not support assigning a plurality of tiles to a single object, which is allegedly recited in step (c). However, as is clear from the specification of U.S. Patent No. 5,208,907 and the file history, this is an unintended interpretation of this claim language. The language of the last two clauses of this step (c), i.e., "at least one of said tiles ... objects," was added in an amendment to overcome prior art and to further define the first clause of this step (c), i.e., "using said processing means, assigning a plurality of tiles to each of said objects in said object list." Then, in a later amendment by applicants, the underlined language "to each of said objects" was added to overcome an antecedent basis objection/rejection (not to overcome prior art), which led to this potential clarity problem and this unintended interpretation of this claim.